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09/773,332	01/31/2001	Michael J. Swain	200308264-2	5528

7590 08/24/2004

IP ADMINISTRATION LEGAL DEPARTMENT  
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EXAMINER

BELIVEAU, SCOTT E

ART UNIT	PAPER NUMBER
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2614

DATE MAILED: 08/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/773,332

**Applicant(s)**

SWAIN ET AL.

**Examiner**

Scott Beliveau

**Art Unit**

2614

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 April 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |  |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)            |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>5</u> . | 6) <input type="checkbox"/> Other: ____  |

**DETAILED ACTION*****Drawings***

1. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include reference sign "39" mentioned in the description (Page 8, Line 25). Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.
2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the reference character "32" not mentioned in the description (Figure 3). Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be

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notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### *Specification*

3. The disclosure is objected to because it contains an embedded hyperlink and/or other form of browser-executable code. Applicant is required to delete the embedded hyperlink and/or other form of browser-executable code. See MPEP § 608.01.

### *Claim Rejections - 35 USC § 102*

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-8, 12, 14-21, 25, 28, 29, and 31 are rejected under 35 U.S.C. 102(e) as being anticipated by Basso et al. (US Pub No. 2002/0124262).

In consideration of claim 1, Basso et al. discloses a “method of providing to a user desired ones of . . . live broadcasts shifted in time” (Figure 1). The method comprises “receiving from a user” [24/26] a “request for content of the broadcast of at least one future event” implicitly comprising the “date, time and network location of respective broadcasts of each requested event” for the purpose of uniquely identifying the particular event for recording ([0030]; [0033]; [0053]). The “working server” [200]

“records” the “respective broadcast . . . being in the form of live streamed video-audio data over the network” ([0024; [0027] ; [0077]) and “upon user command to view a certain one of the requested events, provides the recorded streamed video-audio data corresponding to said certain one of the requested events” to a “digital player” or streaming client application such that the “viewing [is] in a manner time shifted from original broadcast of the certain one of the requested events.” ([0009]; [0010]; [0053])

Claim 14 is rejected in view of claim 1 wherein the method further comprises a “user interface means” such as a web based interface to facilitate the request for recording of “future events” ([0033]; [0053]).

Claim 28 is rejected wherein the Basso et al. method of providing “broadcast data shifted in time”. The method involves “receiving . . . requests to record respective desired broadcast programs” and “recording streamed multimedia data forming the respective desired broadcast programs” ([0030]; [0033]; [0053]). The viewers [24/26] are subsequently “enabled” so as to “view a corresponding program at a time subsequent to ordinal broadcasting of said program” ([0009]; [0010]; [0024; [0027]; [0077]).

Claims 2 and 15 are rejected wherein the method comprises “providing a schedule of events to be broadcast live over the network . . . [that] enables the user to formulate a request” ([0030]; [0033]). In particular, the system is operable to facilitate the pre-selection of scheduled events for recording which would require knowledge of the existence of these scheduled events in order to pre-select them for recording.

Claims 3, 4, 16, and 17 are rejected wherein the “working server” and the “digital player” are “local to each other in the network such that the stop of recording at the working server includes recording local to the digital player”. Alternatively, the “working server” may be at a “third party site in the network remote from the digital player, such that the step of recording includes recording at a network site remote from the digital player” ([0028]).

Claims 5 and 18 are rejected wherein the method may further include “recording some of the broadcasts locally to the digital player” and “recording different ones of the respective broadcasts remotely from the digital player” such that the “providing the recorded streamed video data” may be “synchronized . . . in a manner transparent to the user” ([0036]).

Claims 6, 19, and 29 are rejected wherein the recording includes “caching to cache storage” [204] the “streamed video-audio data corresponding to the respective broadcasts of the requested events” ([0053]; [0056])

Claims 7 and 20 are rejected wherein the “caching includes overwriting the streamed video-audio data in the cache storage corresponding to . . . the least recent broadcast event” ([00072]).

Claims 8 and 21 is rejected wherein the method further “provides a searchable index to the streamed video-audio data in the cache storage” ([0011]; [0031]; [0053]).

Claims 12 and 25 are rejected wherein the Basso et al. reference further “schedules broadcasts to be recorded across multiple users and their requests” (Figure 1; [0024] – [0026]; [0033]).

Claim 31 is rejected wherein the “step of enabling user viewing includes supporting a multimedia rendering of the corresponding desired broadcast program through . . . a computer system” ([0053]).

6. Claims 1-6, 8, 9, 11- 19, 21, 22, and 24-31 are rejected under 35 U.S.C. 102(e) as being anticipated by Ellis et al. (US Pub No. 2003/049988).

In consideration of claim 1, Ellis et al. discloses a “method of providing to a user desired ones of . . . live broadcasts shifted in time”. The method comprises “receiving from a user a request for content of the broadcast of at least one future event” comprising the “date, time and network location of respective broadcasts of each requested event” for the purpose of uniquely identifying the particular event for recording ([0076]; [0084]; [0088]) The “working server” [24/29] “records” the “respective broadcast . . . being in the form of live streamed video-audio data over the network” (Figure 5; [0088]; [0097]) and “upon user command to view a certain one of the requested events, provides the recorded streamed video-audio data corresponding to said certain one of the requested events” to a “digital player” [36] such that the “viewing [is] in a manner time shifted from original broadcast of the certain one of the requested events.” ([0091] – [0093]; [0104]; [0152]; [0153]).

Claim 14 is rejected in view of claim 1 wherein the method further comprises a “user interface means” in the form of an electronic programming guide to facilitate the request for recording of “future events” ([0076]).

Claim 28 is rejected wherein the Ellis et al. method of providing “broadcast data shifted in time”. The method involves “receiving requests from users to record respective desired broadcast programs” and “recording streamed multimedia data

forming the respective desired broadcast programs” ([0076]; [0084]; [0088]). The viewers are subsequently “enabled” so as to “view a corresponding program at a time subsequent to ordinal broadcasting of said program” ([0091] – [0093]; [0104]; 0152]; [0153]).

Claims 2 and 15 are rejected wherein the method comprises “providing a schedule of events to be broadcast live over the network . . . [that] enables the user to formulate a request” ([0074]; [0076]).

Claims 3, 4, 16, and 17 are rejected wherein the “working server” [29] and the “digital player” [36] are “local to each other in the network such that the stop of recording at the working server includes recording local to the digital player”. Alternatively, the “working server” [24] may be at a “third party site in the network remote from the digital player, such that the step of recording includes recording at a network site remote from the digital player” ([0086]).

Claims 5 and 18 are rejected wherein the method may further include “recording some of the broadcasts locally to the digital player” and “recording different ones of the respective broadcasts remotely from the digital player” such that the “providing the recorded streamed video data” may be “synchronized . . . in a manner transparent to the user” ([0086]; [0152]; [0153]; [0156]). In particular, the system determines whether or not to store a program remotely or locally based on the number of requests and subsequently “transparently” presents the requested media to the user.

Claims 6, 19, and 29 are rejected wherein the recording includes “caching to cache storage” [13/15] the “streamed video-audio data corresponding to the respective broadcasts of the requested events” ([0078]; [0079]).



In consideration of claims 8, 9, 21, and 22, the Ellis et al. reference discloses “providing” and recording a “searchable index . . . [including] header information from respective original broadcasts” for providing a means to search for a recorded program of interest based on a plurality of criteria (ex. time, category, title, etc.) ([0118]; [0122]; [0143]).

Claims 11 and 24 are rejected wherein the Ellis et al. reference discloses the limitation wherein the recorded media appears in the electronic program guide and the user may subsequently request and display a “respective summary of the corresponding event” (Figures 11A-C; [0125]; [0154]).

In consideration of claims 12, 13, 25, and 26, the Ellis et al. reference discloses that “scheduling broadcasts to be recorded” is performed “across multiple users and their requests” that media may be stored for a “length of time determined according to user demand across multiple users” such that once all users have demanded to view a recorded program that it is subsequently deleted ([0167] – [0169]).

Claim 30 is rejected wherein the “caching overwrites and saves streamed multimedia data as a function of number of user requests for the corresponding broadcast program” ([0081]).

Claim 31 is rejected wherein the “enabling user viewing includes supporting a multimedia rendering of the corresponding desired broadcast program . . . through a television.” ([0104]).

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).
9. Claims 7, 10, 20, and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ellis et al. (US Pub No. 2003/0149988) in view of Browne et al. (WO 92/22983).

In consideration of claims 7, 10, 20, and 23, the Ellis et al. reference discloses the particular usage of automatically deleting or "overwriting the streamed video-audio data in the cache storage" subsequent to watching or after a predetermined period of time. However, the reference does not particularly disclose nor preclude the deletion based either "the event viewed longest ago by the user" or "the least recent broadcast event". Furthermore, the reference does not provide an interface so as to enable the user to "indicate preference for saving or deleting the streamed video-audio data when the cache storage is full".

The Browne et al. (WO 92/22983) reference discloses that it is known in the art so to “provide interface means for enabling the user to indicate preference for saving or deleting streamed video-audio data when the cache storage is full” (Figures 3 and 6; Page 18, Line 29 – Page 19, Line 30) wherein an event is deleted/overwritten in the cache based on “the least recent broadcast event”. Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made so to modify the Ellis et al. interface so as to provide ability for the user to designate a cache / storage management deletion functionality for the purpose of providing the user with the means and flexibility to control storage options of a storage device of limited capacity.

### *Conclusion*

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure as follows. Applicant is reminded that in amending in response to a rejection of claims, the patentable novelty must be clearly shown in view of the state of the art disclosed by the references cited and the objections made.

- The Shteyn (US Pat No. 6,611,654) reference discloses a server system that enables a subscriber to select a specific broadcast program for recording and replay.
- The Wood et al. (US Pub No. 2003/0044165) reference discloses a video data recorder that comprises storage management and index/searching functionality.

- The Lawler et al. (US Pat No. 5,805,763) reference discloses a program recording system that facilitates remote recording and playback of digital programs.
- The Eyal (US Pat no. 6,389,467) reference discloses system and method for content search and playback of streaming media over a network.
- The Jaismha et al. (US Pat No. 6,487,663) reference discloses a system and method for regulating the transmission of streamed media data comprising indexable header information.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott Beliveau whose telephone number is 703-305-4907. The examiner can normally be reached on Monday-Friday from 8:30 a.m. - 6:00 p.m..

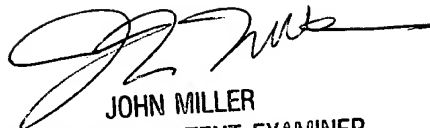
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Miller can be reached on 703-305-4795. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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